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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,819	05/11/2006	Kazuhiko Ueda	2006_0509A	3671
513 7590 09/12/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER MOORE, MARGARET G	
			ART UNIT 1712	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/574,819

Applicant(s)

UEDA ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 to 6 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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1. Applicants' amendment has overcome the rejection over Gutek et al. The newly added language "capable of being crosslinked to form a..." requires that at least some of both (A) and (B) have at least 2 alkenyl groups and Si-H groups (respectively) such that the final composition is able to crosslink. While this is not specifically stated in the claims, it is apparent from the claim language as a whole. Obviously with only one SiH group or one alkenyl group, the reaction product will be terminated rather than cross-linked. This is consistent with that noted by applicants in their response.

The submission of the Declaration by Mr. Kusakabe adequately establishes that there is a typographical error in the JP reference. Even so, a siloxane having only 1 SiH group would not meet the "capable of being crosslinked" requirement noted supra. Applicants' specification compares the closest prior art found in the JP reference, a siloxane having 5 SiH groups, to compositions within the instant claims and shows improved adhesion over the prior art. In this manner both rejections over the JP reference have also been withdrawn.

The amendment has necessitated the following new ground of rejection. These references were found during an updated review of the claims, as amended.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue.

Inoue teaches a curable composition containing the reaction product of polyoxyalkylene having two terminal unsaturated groups and an SiH compound. Particular attention is drawn to Synthetic Examples 1 to 3 on column 6. This shows the reaction between a polyoxyalkylene meeting (A) (and the limitation of claim 6) and a siloxane having 2 SiH groups meeting (B) (and the weight requirement of claim 3). The reaction occurs in the presence of a Pt catalyst meeting (C). This anticipates the instant claims. For claim 4, see the preferred ratio range on the bottom of column 2.

Inoue does not specifically show a crosslinked composition or make reference to forming a pressure sensitive adhesive but the claimed composition is only capable of these properties. Also note that cited in the previous office action (paragraph 1) regarding chemical compositions of an identical nature. The teachings in Inoue do indicate a degree of adhesion since the composition therein is applied to a surface and cured. In addition the Examiner notes that the reaction product in Synthetic Examples 1 to 3 are subsequently crosslinked.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue.

While none of the working examples show a polyoxyalkylene having this molecular weight, note that the upper disclosed limit of 300 for "n" on column 2, lines 25 to 40, embraces molecular weights that fall within the claimed range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). In this manner one having ordinary skill in the art would have found the claimed molecular weight range to have been obvious.

6. Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Eckberg et al.

Eckberg et al. teach a composition prepared by reacting a polyether having two

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terminal allyl groups and an Si-H compound. Particular attention is directed to Example 1 in which TEGDAE (defined on the bottom of column 6) is reacted with a siloxane having terminal SiH groups in the presence of an Pt catalyst. This meets each claimed component in claim 1. Note that cited *supra* and in paragraph 1 of the previous office action regarding the phrase "capable of being crosslinked...".

The siloxane in Example 1 meets claim 3 and the polyether meets claim 6.

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest such a specific siloxane reactant.

8. Iwahara et al. is cited as being of general interest. The working examples show reaction between a siloxane having 4 and 5 SiH groups and a polyether having 2 alkenyl groups.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

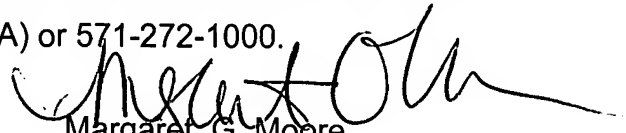
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
9/10/07